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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,150	02/19/2004	Steven J. Reynolds	UV/55 Cont.	7029
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ROPES & GRAY LLP			HANCE, ROBERT J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,150	Applicant(s) REYNOLDS ET AL.
	Examiner ROBERT HANCE	Art Unit 4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 23-62 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 23-62 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 19 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-166/08)
 Paper No(s)/Mail Date 02/19/2004.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: machine-readable media, as cited in claims 47-54 and 61-62, lacks proper antecedent basis in the specification.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 23-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 19-20 of U.S. Patent No.

6,742,183. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

10/783,150 Claim 23:

- a) A system for controlling the presentation of advertisements to a television viewer, comprising: an advertising database that stores an advertisement
- b) wherein said advertisement is a programming-related advertisement for a network, channel, or programming on a network or channel;
- c) television viewer equipment configured to:
 - receive said advertisement from said advertising database;
 - receive advertisement control information associated with said advertisement, wherein said advertisement control information schedules said advertisement for display by said television viewer equipment
- d) determine whether or not said advertisement from said advertising database is for a network, channel, or programming on a network or channel that is received by said television viewer equipment
- e) unschedule said display of said advertisement when said television viewer equipment determines that said advertisement is for a network, channel, or programming on a network or channel that is not received by said television viewer equipment

6,742,183 Claim 1:

- a) A system for controlling the presentation of an advertisement to a television viewer, comprising: an advertising database that stores said advertisement
- b) at least some of said advertisements are programming-related advertisements for a network, channel or programming on a network or channel;
- c) a processor that is a portion of one of a piece of television viewer equipment, (. . .), and that receives from said advertising database said advertisement, that receives advertisement control information associated with said advertisements, wherein: said advertisement control information schedules said advertisements for display by said television viewer equipment
- d) said processor determines whether or not said advertisements that are received from said advertising database are for a network, channel, or programming on a network or channel that is received by said television viewer equipment
- e) for each advertisement that said processor determines is for a network, channel, or programming on a network or channel that is not received by said television viewer equipment, said processor prevents the display of said each advertisements on said television viewer.

While in 10/783,150 claim 23 states that the television view equipment "unschedules" advertisements, claim 1 of 6,742,183 states that the processor that is a portion of one of a piece of television viewer equipment "prevents the display" of the advertisements. It would have been readily apparent to one of ordinary skill in the art at the time of the invention that these are the same functions that have the same outcome.

It would also have been apparent to one of ordinary skill in the art at the time of the invention that "television viewer equipment" and "a processor that is a portion of one of a piece of television viewer equipment" are equivalent. Therefore claim 23 of 10/783,150 is not patentably distinct over claim 1 of 6,742,183.

10/783,150 Claim 24:

The system defined in claim 23 further comprising a program guide database that stores program guide information, wherein said television viewer equipment is further configured to receive said program guide information from said program guide database and use said program guide information to unschedule said display of said advertisement on said television viewer equipment.

6,742,183 Claim 2:

The system defined in claim 1 further comprising a program guide database that stores program guide information, wherein said processor receives from said program guide database said program guide information and uses said program guide information in preventing the display of said each advertisement on said television viewer equipment.

10/783,150 Claim 25:

The system defined in claim 23 further comprising a channel map database that stores channel map information, wherein said television viewer equipment is further configured to receive said channel map information from said channel map database and use said

channel map information to unschedule said display of said advertisement on said television viewer equipment.

6,742,183 Claim 3:

The system defined in claim 1 further comprising a channel map database that stores channel map information, wherein said processor receives from said channel map database said channel map information and uses said channel map information in preventing the display of said each advertisements on said television viewer equipment.

10/783,150 Claim 26:

The system defined in claim 23 wherein said television viewer equipment is further configured to unschedule said display of said advertisement on said television viewer equipment if the channel, network, or programming is unavailable to said television viewer equipment.

6,742,183 Claim 5:

The system defined in claim 1 wherein said processor prevents the display of said each advertisements on said television viewer equipment if the channel, network, or programming is unavailable to said television viewer equipment.

10/783,150 Claim 27:

The system defined in claim 23 wherein said television viewer equipment is further configured to unschedule said display of said advertisement on said television viewer

equipment if the channel, network, or programming is undesired by said television viewer.

6,742,183 Claim 6:

The system defined in claim 1 wherein said processor prevents the display of said each advertisements on said television viewer equipment if the channel, network, or programming is undesired by said television viewer.

10/783,150 Claim 28:

The system defined in claim 23 wherein said television viewer equipment is further configured to unschedule said display of said advertisement on said television viewer equipment when the network, channel, or programming should have corresponding program guide information and does not have said corresponding program guide information.

6,742,183 Claim 7:

The system defined in claim 1 wherein said processor prevents the display of said each advertisements on said television viewer equipment when the network, channel, or programming should have corresponding program guide information and does not have said corresponding program guide information.

10/783,150 Claim 29:

The system defined in claim 23 wherein said advertising database is part of a television distribution facility.

6,742,183 Claim 8:

The system defined in claim 1 wherein said advertising database is part of a television distribution facility.

10/783,150 Claim 30:

The system defined in claim 23 wherein said advertising database is part of a main facility.

6,742,183 Claim 9:

The system defined in claim 1 wherein said advertising database is part of a main facility.

As to claims 31-38, 39-46, and 47-54 see similar rejections to claims 23-30. The method of claims 31-38, the system for controlling of claims 39-46 and the machine readable medium of claims 47-54 correspond to the system of claims 23-30. Therefore claims 31-38, 39-46, and 47-54 have been analyzed and rejected.

10/783,150 Claim 55:

- a) A system for controlling the presentation of advertisements to a television viewer, wherein said advertisements are associated with a television network having a network identifier, comprising:
- b) an advertising database that stores an advertisement; and
- c) television viewer equipment configured to:

- d) receive said advertisement from said advertising database;
- e) receive advertisement control information associated with said advertisement, wherein said advertisement control information schedules said advertisement for display by said television viewer equipment and said advertisement control information contains a network identifier;
- f) use said network identifier to determine whether any affiliate of said network is received by said television viewer equipment; and
- g) unschedule said display of said advertisement when said television viewer equipment determines that said advertisement is for an affiliate of said network that is not received by said television viewer equipment.

6,742,183 Claim 19:

- a) A system for presenting to a television viewer advertisements that is associated with a television network having a network identifier, said system comprising:
- b) an advertising database that stores said advertisements; and
- c) a processor that
- d) receives from said advertising database said advertisements, and that
- e) receives advertisement control information that is associated with said advertisements, wherein: said advertisement control information schedules said advertisements for display by said television viewer equipment and that contains said network identifier;
- f) said processor uses said network identifier to determine whether any affiliate of said network is received by said television viewer equipment; and

g) for each advertisement that said processor determines is for said affiliate that is not received by said television viewer equipment, said processor prevents the display of said each advertisements on said television viewer equipment and selects a substitute advertisement to be displayed on said viewer television equipment instead of said each advertisement.

10/783,150 Claim 56:

The system of claim 55 wherein said television viewer equipment is further configured to implement a program guide application that is configured to unschedule said display of said advertisement on said television viewer equipment when said affiliate is determined not to be received by the television viewer equipment.

6,742,183 Claim 20:

The system of claim 19 wherein said processor further implements a program guide application that prevents the display of said each advertisements on said television viewer equipment when said affiliate is determined not received by the television viewer equipment.

As to claims 57-58, 59-60 and 61-62 see similar rejections to claims 55-56. The method of claims 57-58, the system of claims 59-60 and the machine-readable media of claims 61-62 correspond to the system of claims 55-56. Therefore, claims 57-58, 59-60 and 61-62 have been analyzed and rejected.

Allowable Subject Matter

If the double patenting rejections are overcome, claims 24-62 will be allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HANCE whose telephone number is (571)270-5319. The examiner can normally be reached on M-F 8:00am - 5:00am EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LunYi Lao can be reached on (571) 272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. H./
Examiner, Art Unit 4134

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/LUN-YI LAO/

Supervisory Patent Examiner, Art Unit 4134